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9. (New) A coin dispensing apparatus, as defined in claim 2, wherein during a selling operation, the coins in said holding unit are transferred to said coin storing unit, and

during a returning operation, a passage from said holding unit to said coin storing unit is blocked and the coins in said holding unit are transferred to said coin repayment unit via a repayment passage between said holding unit and said coin repayment unit.

10. (New) A coin dispensing apparatus, as defined in claim 5, wherein during a selling operation, the coins in said holding unit are transferred to said coin storing unit, and

during a returning operation, a passage from said holding unit to said coin storing unit is blocked and the coins in said holding unit are transferred to said coin repayment unit via a repayment passage between said holding unit and said coin repayment unit.—

REMARKS

At the time of the Office Action dated June 3, 2002, claims 1-7 were pending and rejected in this application. Claims 2 and 3 have been amended, and claims 8-10 have been added. Care has been exercised to avoid the introduction of new matter. Specifically, claims 2 and 3 have been amended to address informalities noted by the Examiner. The limitations found in new claims 8-10 find adequate descriptive support throughout the originally filed disclosure, for

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example, on page 12, line 19 through page 13, line 29. Applicants submit that the present Amendment does not generate any new matter issue.

In the second enumerated paragraph of the statement of the rejection, the Examiner asserted that the sorting unit and sorting device of claims 2 and 3 be referred to as "a first sorting unit" and "a second sorting unit." In response, Applicants have amended claim 2 per Examiner's suggestion.

Claims 1-7 are rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones et al., U.S. Patent No. 6,318,537 (hereinafter Jones)

In the fourth enumerated paragraph of the Office Action, the Examiner asserted that Jones discloses a coin dispensing apparatus corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within the public domain. **ATD Corporation v. Lydall, Inc.**, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998); **Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.**, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Furthermore, the Examiner must also establish that the applied reference identically discloses each feature of the claimed invention. **In re Rijckaert**, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); **Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). As part of this analysis,

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the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. **Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra***. That burden has not been discharged.

Claim 1, for example, recites that the holding unit is provided between the coin storing unit and the sorting unit. In the statement of the rejection, the Examiner asserted that the claimed sorting unit is disclosed by reference numeral 32 of Jones, that the coin storing unit is disclosed by reference numeral 40, and that the holding unit is disclosed by references numerals 52, 54, 56, or 402a-f. However, as clearly indicated by Fig. 3 of Jones, the receptacles/containers 52, 54, 56 of Jones are part of the coin station 40 (column 7, lines 35-60). Furthermore, the receptacles/containers 52, 54, 56 are not between the coin station 40 and the coin processing module 32, as is recited in claim 1. Instead, the receptacles/containers 52, 54, 56 are the last stop in the path of the coins. Thus, Jones fails to identically describe the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Independent claims 2 and 5 similarly recite that the coins from the sorting unit are temporally held in the holding unit and that the coins in the holding unit are then sorted to the storing unit of the coin repayment unit. Thus, Jones also fails to identically describe the claimed invention, as recited in claims 2 and 5, within the meaning of 35 U.S.C. § 102.

With regard to claim 2, Applicants note that the Examiner stated: "it would be obvious to provide a second sorting device." In response, the Examiner is reminded that a proper rejection

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under 35 U.S.C. § 102 requires the applied prior art to disclose all of the claimed limitations. If the Examiner is to allege that it would have been obvious to modify the applied prior art to arrive at the claimed invention, then the Examiner must reject the claim only under 35 U.S.C. § 103.

Applicants also note the Examiner's comments regarding the inherency of the diverter mechanism. In this regard, the Examiner is reminded that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. **In re Robertson**, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); **In re Rijckaert**, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); **In re Oelrich**, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Instead, the Examiner is burdened to establish that the missing element must necessarily result from the prior art reference. **Continental Can Co. USA v. Monsanto Co.**, 20 USPQ 2d 1746 (Fed. Cir. 1991); **Ex parte Levy**, 17 USPQ2d 1461 (BPAI 1990). This burden has not been met.

The Examiner referred to Fig. 5 and column 8, lines 27-35 for the disclosure of the claimed wiper unit. In response, Applicants note that the Examiner has failed to construe the term "wiper unit" consistent with the specification. In so doing, the Examiner has inappropriately asserted that Jones discloses the claimed wiper unit.

Applicants have also introduced new claims 8-10, which recite that during a selling operation, the coins in the holding unit are transferred to the coin storing unit, and during a returning operation, a passage from the holding unit to the coin storing unit is blocked and the coins in the holding unit are transferred to the coin repayment unit via a repayment passage between the holding

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unit and the coin repayment unit. These features are neither taught nor suggested by Jones. As such, claims 8-10 further distinguish the claimed invention from the applied prior art.

The above argued differences between the coin dispensing apparatus defined in independent claims 1, 3 and 5 and the device of Jones undermine the factual determination that Jones identically describes the claimed invention within the meaning of 35 U.S.C. § 102. **Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.**, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); **Kloster Speedsteel AB v. Crucible Inc.**, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, respectfully submit that the imposed rejection of claim 1-7 under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones is not factually viable and, hence, solicit withdrawal thereof.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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Version with markings to show changes made

IN THE CLAIMS:

2. (Amended) A coin dispensing apparatus, comprising:

an inserting aperture, provided at an upper part of a main body, for receiving coins to be inserted thereinto;

a first sorting unit comprising a coin discriminating device for discriminating genuineness of coins inserted into said inserting aperture, said sorting unit sorting said coins discriminated in said coin discriminating device;

a holding unit for temporally holding said coins sorted in said first sorting unit;

a coin storing unit provided under said holding unit; and

a coin repayment unit, provided at a lower part of said main body, for returning said coins to a customer;

wherein said coin dispensing apparatus has

a holding cylinder provided in said holding unit for temporally holding said coins,

a wiper provided at a lower part of said housing cylinder for sweeping said coins, and

a second sorting [device] unit provided under said wiper for sorting said coins to said coin storing unit or said coin repayment unit.

3. (Amended) A coin dispensing apparatus, as defined in claim 2, wherein:

said coin dispensing apparatus has a coin storing passage connected with said coin storing unit and a repayment passage connected with said coin repayment unit, and a damper provided in said second sorting [device] unit for switching said coin storing passage and said repayment passage.

Please add the following:

--8. (New) A coin dispensing apparatus, as defined in claim 1, wherein

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during a selling operation, the coins in said holding unit are transferred to said coin storing unit, and

during a returning operation, a passage from said holding unit to said coin storing unit is blocked and the coins in said holding unit are transferred to said coin repayment unit via a repayment passage between said holding unit and said coin repayment unit.

9. (New) A coin dispensing apparatus, as defined in claim 2, wherein

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during a returning operation, a passage from said holding unit to said coin storing unit is blocked and the coins in said holding unit are transferred to said coin repayment unit via a repayment passage between said holding unit and said coin repayment unit.

10. (New) A coin dispensing apparatus, as defined in claim 5, wherein

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during a returning operation, a passage from said holding unit to said coin storing unit is blocked and the coins in said holding unit are transferred to said coin repayment unit via a repayment passage between said holding unit and said coin repayment unit.—